Supreme Court, U.S.
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In The

Supreme Court of the United States

SEMITOOL, INC.,

Petitioner,

v.

NOVELLUS SYSTEMS, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

MORGAN CHU*
JONATHAN H. STEINBERG
SAMUEL K. LU
IRELL & MANELLA LLP
1800 Avenue of the Stars
Suite 900
Los Angeles, California 90067
(310) 277-1010

**Counsel of Record*

Attorneys for Respondent Novellus Systems, Inc.

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

QUESTION PRESENTED

1. Whether this Court's grant of certiorari in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000), *petition for cert. granted* (June 18, 2001) (No. 00-1543), to review the holdings of the Federal Circuit regarding prosecution history estoppel *by amendment* provides a basis for granting certiorari in this case, where arguments made by the Petitioner during prosecution give rise to a prosecution history estoppel *by argument*, and where the result below would be unaffected by this Court's decision in *Festo*.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 29.6 of the Rules of the Supreme Court of the United States, Respondent Novellus Systems, Inc. ("Novellus") respectfully submits this Corporate Disclosure Statement.

Novellus has no parent company. No publicly held company owns ten percent (10%) or more of Novellus' stock.

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RESPONSE IN OPPOSITION ON BEHALF OF RESPONDENT

In this case, the United States Court of Appeals for the Federal Circuit found that, during the prosecution of U.S. Patent Nos. 5,222,310 and 5,377,708 (the " '310 and '708 patents", respectively), Petitioner Semitool, Inc. ("Semitool") made arguments which "expressly disclaimed coverage" of the subject matter that Semitool seeks to reach by invoking the doctrine of equivalents. Because these arguments give rise to a prosecution history estoppel *by argument*, which is not the subject of the Federal Circuit's holdings in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000), *petition for cert. granted* (June 18, 2001) (No. 00-1543), regarding prosecution history estoppel *by amendment*, the outcome of this case does not depend upon this Court's decision in *Festo*. Respondent Novellus therefore respectfully requests that this Court deny the Petition for Writ of Certiorari ("Petition") filed by Semitool.

COUNTER-STATEMENT OF THE CASE

During the prosecution of the '310 and '708 patents, Semitool not only amended the claims to add the "substantially enclosed" processing space limitation discussed by the Federal Circuit, but also advanced arguments in support of the patentability of these claims. Semitool unmistakably argued that the claims were distinguishable over the prior art cited by the United States Patent and Trademark Office ("PTO") because the recited processing space was capable of containing gaseous processing

chemicals and, unlike the cited prior art, enclosed the wafer to permit effective gas processing:

> [Claim 1] has been amended to recite that the complementary processing head and processing base define a substantially enclosed processing space when in the closed relative position. This allows the processing space to contain the gaseous or liquid processing chemicals. The Aigo reference has no ability to enclose the wafer and cannot process effectively using gases.[1]

On the basis of these arguments to the PTO, the Federal Circuit concluded that "Semitool *expressly disclaimed coverage* under the ['310] patent of any wafer processing tool that cannot effectively utilize the gas phase of a processing chemical."[2] The Federal Circuit found that Semitool had relinquished this subject matter in the '708 patent as well.[3] As a result, the Federal Circuit interpreted the claims at issue to require, among other things, that the "substantially enclosed" processing space must be capable of "effective gas processing".[4]

In affirming the district court's decision that Novellus' SABRE tools do not infringe the '310 and '708

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[1] Petition App. at 10-11 ('310 patent prosecution history, Paper No. 8 at 5, quoted in *Semitool, Inc. v. Novellus Sys., Inc.*, 2001 U.S. App. Lexis 11986 (the "Federal Circuit Opinion")).

[2] Petition App. at 11 (the Federal Circuit Opinion) (emphasis added).

[3] *See* Petition App. at 11 (the Federal Circuit Opinion) ("Semitool's relinquishment of subject matter during prosecution of the '310 patent applies with equal force to the '708 patent.").

[4] *See* Petition App. at 12 (the Federal Circuit Opinion).

patents, the Federal Circuit held that "[w]e find no error in the [district] court's determination that Semitool failed to establish a genuine issue of material fact that the SABRE systems are capable of effective gas processing. . . . "[5]

REASONS FOR DENYING THE PETITION FOR WRIT OF CERTIORARI

I. The Holdings of *Festo* Are Limited to Prosecution History Estoppel *by Amendment*, and Do *Not* Discuss Prosecution History Estoppel *by Argument*

A prosecution history estoppel may arise in one of two fashions: by amendment or by argument. *See Desper Prods., Inc. v. Qsound Labs, Inc.*, 157 F.3d 1325, 1338 (Fed. Cir. 1998) ("Amendments made to overcome a prior art rejection can create such an estoppel. . . . Unequivocal assertions or arguments made during prosecution may also create an estoppel.") (citations omitted); *CAE Screenplates, Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1319 (Fed. Cir. 2000) (A prosecution history estoppel may arise "either by amendment or argument."); *Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322 (Fed. Cir. 1999) ("Prosecution history estoppel applies to matter surrendered as a result of amendments . . . and as a result of argument. . . . ") (citations omitted). Indeed, a prosecution history estoppel may arise from argument alone. *See Canton Bio-Medical, Inc. v. Integrated Liner Tech., Inc.*, 216 F.3d 1367, 1371 (Fed. Cir. 2000) ("[A]mendment is not

[5] Petition App. at 18 (the Federal Circuit Opinion).

essential [to create an estoppel] when argument is made, and relied on, to distinguish the claimed subject matter from the prior art.") (citation omitted); *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 828 n.3 (Fed. Cir. 1999) ("[E]ven arguments made during prosecution without amendments to claim language . . . may estop an applicant. . . . ") (citation omitted); *Haynes Int'l, Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1579 (Fed. Cir. 1993) ("[A]n estoppel can be created even when the claim . . . was not amended during prosecution.").

The first type of prosecution history estoppel, *by amendment*, is the subject of the Federal Circuit's holdings in *Festo*. *See, e.g.*, 234 F.3d at 574 ("We hold that prosecution history estoppel acts as a complete bar to the application of the doctrine of equivalents *when an amendment* has narrowed the scope of a claim for a reason related to patentability." (emphasis added). Indeed, questions 1-4 and the answers that the Federal Circuit provided to those questions are all limited to prosecution history estoppel *by amendment*. *See Festo*, 234 F.3d at 563-564. The second type of prosecution history estoppel, *by argument*, was not relied upon by the Federal Circuit in *Festo*, and the Federal Circuit's decision in no way affected the long-established principles upon which this type of estoppel is based.[6]

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[6] Prosecution history estoppel *by argument* was briefly mentioned in *Festo*, but only as further support for one of the Federal Circuit's holdings relating to prosecution history estoppel *by amendment*. *See* 234 F.3d at 568.

II. Semitool Surrendered Coverage of Tools That Are Not Capable of Effective Gas Processing in a Prosecution History Estoppel *by Argument*

The case law is settled that arguments made voluntarily during prosecution give rise to a prosecution history estoppel if they evidence an unmistakable surrender of subject matter. *See Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1252 (Fed. Cir. 2000); *Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.*, 170 F.3d 1373, 1377 (Fed. Cir. 1999); *Desper*, 157 F.3d at 1340; *CAE Screenplates*, 224 F.3d at 1319; *Canton*, 216 F.3d at 1371.

In this case, the Federal Circuit correctly found that Semitool had "expressly disclaimed coverage . . . of any wafer processing tool that cannot effectively utilize the gas phase of a processing chemical."[7], [8] Thus, Semitool's

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[7] Petition App. at 11 (the Federal Circuit Opinion); *see also* Petition App. at 11 (the Federal Circuit Opinion) ("Semitool's relinquishment of subject matter during prosecution of the '310 patent applies with equal force to the '708 patent.").

[8] Semitool asserts that, in amending the claims in response to the prior art, it "did not specifically surrender any subject matter other than devices with open or largely unenclosed processing areas" as purportedly disclosed in the prior art. Petition at 8. In making this assertion, Semitool ignores its arguments to the PTO regarding effective gas processing. Indeed, the Federal Circuit rejected Semitool's assertion: "Although Semitool argues that it only disclaimed coverage for wafer processing tools that process wafers outside of the region defined by the head and the bowl, that interpretation would require us to ignore its statement requiring the tool to be capable of effective gas processing – a statement that is divorced from any concept of 'containing' the wafer and processing chemical in any particular processing space." Petition App. at 11 (the Federal Circuit Opinion).

own arguments, part of the public record of the '310 and '708 patents, give rise to a prosecution history estoppel which precludes Semitool from obtaining coverage under the doctrine of equivalents for tools that are not capable of effective gas processing,[9] such as Novellus' SABRE tools. The district court properly found, and the Federal Circuit affirmed, that Semitool failed to establish a genuine issue of material fact that Novellus' SABRE tools are capable of effective gas processing.[10]

III. The Outcome of This Case, in Which Prosecution History Estoppel *by Argument* Provides an Independent Basis for the Result Below, Does Not Depend upon this Court's Decision in *Festo*

Semitool suggests that the outcome of this case depends upon this Court's decision in *Festo*, and therefore, requests that this Court hold the Petition in this case until this Court has reviewed the Federal Circuit's decision in *Festo*. *See* Petition at 7-9. However, because the

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[9] The range of equivalents for the contested claim language in this case is limited by both prosecution history estoppel *by argument* and by prosecution history estoppel *by amendment*. However, prosecution history estoppel *by argument*, standing alone, suffices to preclude Semitool from obtaining coverage under the doctrine of equivalents for tools that are not capable of effective gas processing. *See Bayer*, 212 F.3d at 1252 (where the Federal Circuit chose to rely on Applicant's argument rather than Applicant's related amendment as a basis for prosecution history estoppel). Thus, this Court need not decide *Festo* before denying Semitool's Petition because it can choose to decide this case by relying on prosecution history estoppel *by argument* alone.

[10] Petition App. at 18 (the Federal Circuit Opinion).

holdings of *Festo* are limited to prosecution history estoppel *by amendment*, the outcomes of cases involving prosecution history estoppel *by argument*, including this case, do not depend upon this Court's decision in *Festo*. There is no reason for this Court to hold Semitool's Petition.

CONCLUSION

For all of the foregoing reasons, Novellus respectfully requests that this Court deny Semitool's Petition now. The Federal Circuit found that Semitool's arguments during the prosecution of the '310 and '708 patents "expressly disclaimed coverage" of what Semitool seeks to cover under the doctrine of equivalents. Because these arguments give rise to a prosecution history estoppel *by argument*, which is not the subject of the Federal Circuit's holdings in *Festo*, the outcome of this case does not depend upon this Court's decision in *Festo*.

Respectfully submitted,

MORGAN CHU*
JONATHAN H. STEINBERG
SAMUEL K. LU
IRELL & MANELLA LLP
1800 Avenue of the Stars
Suite 900
Los Angeles, California 90067

**Counsel of Record*